

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
March 14, 2000

8/15/00

Paper No. 27
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Franklin Resources, Inc.

Serial No. 75/237,021

Ina J. Risman and Beth Goldman of Heller Ehrman White &
McAuliffe for Franklin Resources, Inc.

Elliot S.A. Robinson III, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney)

Before Hanak, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark MUTUAL DISCOVERY for services recited in the
application as "investment management services and mutual
fund advisory, distribution and administration services."¹

¹ Serial No. 75/237,021, filed February 5, 1997. The application
is based on use in commerce under Trademark Act Section 1(a), 15
U.S.C. §1051(a). December 31, 1992 is alleged in the application
(as amended) as the date of applicant's first use of the mark
anywhere and first use of the mark in commerce. Applicant has
asserted a claim of acquired distinctiveness under Trademark Act
Section 2(f) as to the word MUTUAL, and the Trademark Examining
Attorney has accepted that claim.

The Trademark Examining Attorney has refused registration of applicant's mark pursuant to Trademark Act Section 2(d), on the ground that applicant's mark, as applied to applicant's services, so resembles each of three registered marks owned by a single entity (The Prudential Insurance Company of America) as to be likely to cause confusion, to cause mistake, or to deceive. The first cited registration is of the mark DISCOVERY for "underwriting life insurance and providing and administering annuity plans."² The second cited registration is of the mark DISCOVERY PREFERRED for "providing and administering annuities."³ The third cited registration is of the mark DISCOVERY SELECT for "underwriting and administration of annuities."⁴

When the refusals were made final, applicant filed a notice of appeal and a request for reconsideration, with additional evidence and argument. The Trademark Examining Attorney was not persuaded, and continued his final refusals. Applicant and the Trademark Examining Attorney then filed their main appeal briefs, and applicant filed a

² Registration No. 1,566,309, issued November 14, 1989. Affidavits under Sections 8 and 15 accepted and acknowledged.

³ Registration No. 2,007,260, issued October 8, 1996.

⁴ Registration No. 2,096,110, issued September 9, 1997.

reply brief. An oral hearing was held, at which the Trademark Examining Attorney and counsel for applicant were present.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We begin with an analysis of the evidence pertaining to the similarity or dissimilarity of applicant's and registrant's respective services, as well as the similarity or dissimilarity of the trade channels and classes of customers for those services. Applicant appears to be correct in arguing that life insurance, annuities, and mutual funds are quite distinct investment vehicles which would not be confused with each other. However, the issue to be determined is not whether the parties' particular services would be confused with each other, but rather whether those services are sufficiently commercially related that purchasers would be likely to mistakenly assume they originate from the same or a related source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The Trademark Examining Attorney has presented evidence, including third-party registrations and third-party website advertisements, which is sufficient to show that it is common for a single source to offer each of these types of investment products and services. Indeed, it appears from registrant's web page, a printout of which has been made of record by the Trademark Examining Attorney, that registrant itself offers mutual funds as well as annuities and insurance services, albeit apparently not under the DISCOVERY mark. In view of this evidence, we conclude that applicant's recited services and the registrant's recited services are similar, rather than dissimilar. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). This factor weighs in favor of a finding of likelihood of confusion.

There are no restrictions as to trade channels or classes of customers in either applicant's application or the cited registrations, and we accordingly must presume that both applicant and registrant offer their respective services in all normal trade channels and to all normal classes of customers for such services. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981). These factors, as well, weigh in favor of a likelihood of confusion finding in this case.

Despite the similarity of the respective services, and of the trade channels and classes of customers for those services, we nonetheless conclude that there is no likelihood of confusion in this case. Any likelihood of confusion which might otherwise arise due to the relationship between the respective services is effectively dispelled, we believe, by the dissimilarities between the respective marks and by the sophistication of the purchasers and the care with which the respective services are purchased.

Applicant's mark MUTUAL DISCOVERY and registrant's marks DISCOVERY, DISCOVERY PREFERRED and DISCOVERY SELECT obviously are similar to the extent that they all consist of or contain the word DISCOVERY. However, it remains to be decided whether the presence of the word MUTUAL in applicant's mark suffices to distinguish the marks when they are viewed in their entireties.

We are not persuaded by applicant's contention that DISCOVERY is a weak term as applied to the services involved in this case. Applicant has not presented any evidence to support its contention that DISCOVERY is commonly used in the names of the mutual funds of third parties and is suggestive of a type of mutual fund, and we decline applicant's request that we take judicial notice of

such alleged facts under Fed. R. Evid. 201. Likewise, applicant's submission of various third-party registrations⁵ of marks in the financial services field which include the word DISCOVERY or DISCOVER does not persuade us of the weakness of the term. Those registrations are not evidence that the third-party marks are in use or known to consumers, nor do they persuade us that DISCOVERY has a particular accepted meaning in the financial services field. See, e.g., *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed Cir. 1992); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In sum, we cannot conclude on this record that registrant's DISCOVERY marks are entitled to a narrowed scope of protection, nor that the word DISCOVERY is of little consequence in the commercial impression created by applicant's mark.

However, we likewise are not persuaded by the Trademark Examining Attorney's argument that the word MUTUAL appearing in applicant's mark should be accorded little or no weight in our determination of the mark's

⁵ Applicant's third-party registration evidence was submitted in the form of a commercial trademark search report. However, the Trademark Examining Attorney has not objected to the form of this evidence, but rather has discussed the evidence as if it had properly been made of record. Accordingly, we have considered the evidence for whatever probative value it might have.

commercial impression. Rather, we agree with applicant's contention that MUTUAL is the dominant feature, or at least a highly significant feature, in the commercial impression created by applicant's mark. The evidence made of record by applicant establishes that applicant provides and administers a family of mutual funds, each of which is known by a name consisting of the word MUTUAL followed by another word, i.e., MUTUAL SHARES, MUTUAL QUALIFIED, MUTUAL BEACON, MUTUAL EUROPEAN, and MUTUAL FINANCIAL, as well as MUTUAL DISCOVERY. The evidence also establishes that the relevant purchasing public readily recognizes MUTUAL SERIES as the "family" mark identifying and distinguishing applicant's various mutual funds. Applicant has submitted literally hundreds of magazine and newspaper articles in which applicant's funds are editorially referred to as the MUTUAL or MUTUAL SERIES family of funds. Moreover, it appears that the daily financial page listings in several major newspapers identify and list applicant's various mutual funds under the heading MUTUAL or MUTUAL SERIES.

In view of this evidence, we find that the word MUTUAL contributes significantly to the commercial impression of applicant's mark MUTUAL DISCOVERY, and indeed that the presence of this "family" component in applicant's mark is

sufficient to enable purchasers to distinguish applicant's mark from the three cited registered marks.

The Trademark Examining Attorney argues that the three cited registered marks, i.e., DISCOVERY, DISCOVERY PREFERRED and DISCOVERY SELECT, comprise registrant's "family" of DISCOVERY marks used in connection with annuity and life insurance products, and that purchasers, when they encounter mutual fund services offered under the mark MUTUAL DISCOVERY, are likely to assume that registrant is offering such services under another of its DISCOVERY family of marks. Although that scenario is not wholly implausible, we believe it is more likely that mutual fund purchasers, who already are aware that applicant owns and uses a family of MUTUAL marks for mutual fund services, will correctly assume that MUTUAL DISCOVERY is but another member of applicant's family of marks, used in connection with another of applicant's MUTUAL SERIES family of mutual funds.

Finally, one *du Pont* likelihood of confusion evidentiary factor which we believe is entitled to significant weight in this case is the sophistication of the purchasers of the respective services offered by registrant and applicant, and the high degree of care taken in the purchasing decision. Investments such as mutual

funds, annuities and life insurance are expensive purchases which are not likely to be made on impulse or without careful consideration. Indeed, it appears from the record that such purchases commonly are made through or with the assistance of professional investment or financial advisors, or, at the very least, after careful consideration of a prospectus or of other detailed informational materials. The marketing of these respective investment products is controlled by various governmental and industry regulatory provisions and practices which are designed to enhance and maximize the purchaser's awareness of what he or she is buying and the care with which the purchasing decision is made. Although it is settled that even sophisticated purchasers are not necessarily immune to source confusion, we believe that, in the present case, the circumstances surrounding the marketing and purchase of the respective services involved in this case are such as to minimize or eliminate any possible likelihood of source or other confusion.

In summary, we find on the present record that applicant's mark, as applied to applicant's recited services and as encountered by sophisticated, careful purchasers who are likely to be familiar with applicant's MUTUAL SERIES family of mutual funds, does not so resemble

registrant's DISCOVERY, DISCOVERY PREFERRED or DISCOVERY SELECT marks, used in connection with life insurance and annuity products, as to be likely to cause confusion, to cause mistake, or to deceive. Accordingly, we conclude that registration of applicant's mark is not barred by Trademark Act Section 2(d).

Decision: The three Section 2(d) refusals to register are reversed.

E. W. Hanak

C. M. Bottorff

G. F. Rogers

Administrative Trademark Judges
Trademark Trial and Appeal Board